

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Patent Appln. No.: 10/796,197  
Attorney Docket No.: Q79931

### **REMARKS**

Claims 1-11 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 3, and 6. Claims 4, 5, 8, and 10 are editorially amended for conformity therewith and to cure minor informalities. Applicant also adds claims 12-17, which are clearly supported throughout the specification. Finally, the specification is amended to remedy minor informalities noted by the Examiner. No new matter is being added.

#### **I. Preliminary Matters**

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority and for indicating receipt of the certified copy of the priority document.

#### **II. Summary of the Office Action**

The Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5). Claim 10 is objected to because of minor informalities. Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph. Claims 1-5 and 7-10 are rejected under 35 U.S.C. §102(e). Finally, claims 6 and 11 are rejected under 35 U.S.C. §103(a).

#### **III. Drawings Objection**

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include characters not mentioned in the description. Applicant is amending paragraphs no. [28] and [30] of the specification to overcome this objection. Accordingly, Applicant respectfully requests that the objection of the drawings be reconsidered and withdrawn. No new matter is being added.

IV. Claim Objection

Claim 10 is objected to for reasons set forth at page 3 of the Office Action. Applicant is amending the claim to overcome this objection. Accordingly, Applicant respectfully requests that the objection of claim 10 be reconsidered and withdrawn.

V. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-11 are rejected under 35 U.S.C. § 112, second paragraph, for reasons set forth at pages 3-5 of the Office Action. Applicant is amending claims 1, 3-5, and 8 to overcome this objection and to cure the minor informalities noted by the Examiner. Accordingly, Applicant respectfully requests that the rejection of claims 1-11 be reconsidered and withdrawn.

VI. Prior Art Rejections

1. Claims 1-5 and 7-10 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,278,452 to Huberman et al. (hereinafter "Huberman"). Applicants respectfully traverse these grounds of rejection in view of the following comments.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil co. of California*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987).

Of the rejected claims, only claims 1 and 8 are independent. With reference first to claim 1, Huberman does not disclose or even suggest at least the following feature recited in claim 1: "forming a single result directory tree in which the structural or content differences between the compared files or folders are displayed on the upper levels of the result directory tree by predefined graphic markings, wherein the predefined graphic markings indicate origin of the

compared files or folders; and displaying the single result directory tree on the graphic display unit.”

That is, in an exemplary embodiment of the present invention, the origin of a file or folder that is different in the two trees being compared is identified by a graphical marking in the result directory tree. Specifically, in an exemplary embodiment of the present invention, the origin is the source or the initial location of the respective file or folder *i.e.*, whether the file or folder was present in the first tree or the second tree of the two trees being compared. “As a result, for example, an additional folder present in the first directory tree can be highlighted in blue, whereas an additional folder present in the second directory tree can be highlighted in green [in the result directory tree].” *See* paragraph no. [14] of the Specification. Consequently, the colors blue and green represent the origin of the additional folders in this example. That is, the folders that do not appear in both trees being compared will appear in blue or green in the result tree. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claim mentioned above.

The Examiner considers the representations of the results as displayed predefined graphic markings as illustrated in Huberman, Figures 11A-11F. These figures are described in Huberman starting at Col. 8, Line 45. Specifically, Huberman discloses that for each object in the first source that is added as a node to the tree a second node symbol is added beside the first source symbol. Although, the comparison is displayed in a directory tree, a comparison is possible only on a single lowest level of the directory tree (Fig. 12). Therefore, a user must

manually open each level of the directory tree to get a comparison result. Huberman, however, does not disclose or suggest the origin of the structural or content differences between the compared files or folders being displayed on the upper levels of the result directory tree. By contrast, Huberman teaches a “different” status symbol that only indicates on an upper level of the tree that objects are not equal. *See* Col. 12, Lines 15-19. When a tree node is collapsed in Huberman, the comparison results are hidden. *See* Col. 11, Lines 11-16. In other words, in Huberman, on the upper levels of the result directory tree, it is unclear whether the differences are coming from a first tree, a second tree, or both. That is, Huberman does not disclose or even remotely suggest graphically marking upper levels of the directory with the origin or source of the differences.

Therefore, “forming a single result directory tree in which the structural or content differences between the compared files or folders are displayed on the upper levels of the result directory tree by predefined graphic markings, wherein the predefined graphic markings indicate origin of the compared files or folders; and displaying the single result directory tree on the graphic display unit,” as set forth in claim 1, is not disclosed by Huberman, which lacks at least indicating origin of the difference between the two trees being compared in the upper levels of the result directory tree. Accordingly, Applicant respectfully submits that claim 1 is patentable over Huberman and that claims 2-5, and 7 are patentable at least by virtue of their dependence on claim 1. Applicant respectfully requests that the rejection of claims 1-5, and 7 over Huberman be reconsidered and withdrawn.

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2. Regarding claims 8-10, the Examiner contends that the independent claim 8 is directed to a system claim, but is substantially encompassed in method claim 1. Therefore, claim 8 is rejected under the same rationale as claim 1. Applicant has already demonstrated that the teaching of Huberman does not meet all requirements of claim 1. Therefore, arguments presented with respect to claim 1 are respectfully submitted to apply with equal force here. For at least substantially analogous exemplary reasons, independent claim 8 is patentably distinguishable from Huberman. Claims 9-10 are patentable at least by virtue of their dependence on claim 8.

3. Claims 6 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huberman in view of U.S. Patent No. 6,912,707 to Fontes (hereinafter "Fontes"). Applicant respectfully traverses these grounds of rejection in view of the following comments.

In order to establish a *prima facie* case of obviousness, the Examiner must establish three basic criteria. First, there must be some suggestion or motivation, in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the references' teachings. Second, the Examiner must show that there is a reasonable expectation of success in combining or modifying the references. Third, the Examiner must show that the prior art reference or references, or asserted teachings, teach or suggest all of the claim limitations in the rejected claims. See Manual Of Patent Examining Procedure ("MPEP") § 2142. Furthermore, "[i]n rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness." In re

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Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The current grounds of rejection do not meet the above three criteria.

Regarding the requirement that the prior art provide the teaching or suggestion to modify the references or to combine the references' teachings, the Federal Circuit has stated that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), citing, e.g., In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

The Federal Circuit goes on to emphasize that the "need for specificity pervades this authority." In re Lee at 1433 (emphasis added) (citing In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

The current grounds of rejection do not satisfy the Federal Circuit's rigorous standard for demonstrating that the claimed invention would have been obvious in view of the combination of Huberman and Fontes.

For example, claim 6 recites: "the files and folders, that are identically present with respect to their identity and object attributes in the compared directory trees, are shown unmodified in the single result directory tree without any of the predefined graphic markings."

The Examiner acknowledges that Huberman fails to teach identical compared files and folders represented without any of the predefined graphic markings. However, the Examiner contends that the combined disclosure of Huberman and Fontes suggest the above-noted unique feature of claim 6. Applicant has carefully studied the combined disclosure of Huberman and Fontes, and Applicant respectfully submits that Huberman and Fontes do not disclose or suggest at least having the files and folders, that are identically present with respect to their identity and object attributes in the compared directory trees, are shown unmodified in the single result directory tree without any of the predefined graphic markings.

Fontes allows two or more graphical software objects to be compared. Differences between drawing versions can be reconciled. A comparison of a directory, containing collections of drawings can be performed and a summary is shown in result order. *See* Col. 7, Lines 27-34 and Lines 60-61.

The visualization of the comparison result in Fontes is achieved by the result marking “same”. Without that result marking one can not determine whether files are equal or not. Consequently, the text result marking serves at least as a marking. That is, Fontes does not disclose or suggest identical compared files and folders represented without any of the predefined graphic markings.

Consequently, Fontes does not cure the deficiency of Huberman. Therefore, Huberman does not disclose or suggest the above-noted unique feature of claim 6 in view of Fontes. Applicant respectfully requests that the rejection of claim 6 over Huberman in view of Fontes be reconsidered and withdrawn.

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Claim 11 depends on claim 8. Applicant has already demonstrated that the teaching of Huberman does not meet all requirements of claim 8. Moreover, Fontes fails to cure the deficiencies of Huberman. Since claim 11 depends on claim 8, it is patentable at least by virtue of its dependency. Therefore, Applicant respectfully requests that the rejection of claim 11 over Huberman in view of Fontes be reconsidered and withdrawn.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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